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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/762,937

01/21/2004

Alexander G. MacInnis

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01/09/2009

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EXAMINER

BRIER, JEFFERY A

ART UNIT

PAPER NUMBER

2628

MAIL DATE

DELIVERY MODE

01/09/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/762,937

**Applicant(s)**

MACINNIS ET AL.

**Examiner**

Jeffery A. Brier

**Art Unit**

2628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 21-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 11/18/2008 has been entered.

### ***Status of Claims***

2. Claims 35-39 were cancelled and claims 21-34 were allowed in the Examiner's Amendment mailed on 09/02/2008, thus, claims 21-34 are currently pending and claims 1-20 and 35-39 have been cancelled. In view of *In re Bilski* previously allowed claims 21-34 are rejected as being directed to non-statutory subject matter.

### ***Response to Amendment***

3. No amendments were filed with the 1/18/2008 response.

### ***Response to Arguments***

4. No arguments were filed with the 11/18/2008 response.

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 21-34 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 28-34:

These method claims claim an abstract idea without claiming a physical transformation or a specific machine. In *re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008). The "indicating, in the data structure" steps are abstract ideas and the "generating the pixels" step is an abstract mathematical algorithm. The "indicating, in the data structure" steps of dependent claims 29 and 32 are abstract. The claimed graphics image format of dependent claims 30 and 31 are abstract. The alpha value selection of dependent claim 33 is abstract. The applying the alpha value of dependent claim 34 is abstract.

These claims do not claim the type of graphic image and claim to generate pixels for the graphic image. Note page 1397 of *Bilski* which states:

We further note for clarity that the electronic transformation of the data itself into a visual depiction in *Abele* was sufficient; the claim was not required to involve any transformation of the underlying physical object that the data represented. We believe this is faithful to the concern the Supreme Court articulated as the basis for the machine-or-transformation test, namely the prevention of pre-emption of fundamental principles. So long as the claimed process is limited to a practical application of a fundamental principle to transform specific data, and the claim is limited to a visual depiction that represents specific physical objects or substances, there is no danger that the scope of the claim would wholly pre-empt all uses of the principle.

These claims fail to claim "a visual depiction that represents specific physical objects or substances" as required by *In re Bilski*. Thus, these claims preempt all substantial uses of the abstract idea.

Claims 21-27:

These system claims correspond to method claims 28-34 and are non-statutory for the same reasons given for method claims 28-34. These system claims claim an abstract idea without claiming a physical transformation or a specific machine. In view of *In re Bilski*'s reference to *In re Abele* the nominal apparatus limitations, memory and graphics processor, of these system claims do not limit the claimed method to a physical transformation or a specific machine and are considered to be insignificant extra-solution activity. Additionally the generically claimed graphics processor is considered not to be a specific machine and the claimed graphics processor is not claimed to perform the claimed method. Note the discussion of apparatus claim 7 corresponding to method claim 5 in *In re Abele*. *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008). *In re Abele* and *Marshall*, 214 USPQ 682 (C.C.P.A. 1982). Thus, these claims preempt all substantial uses of the abstract idea.

***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffery A. Brier whose telephone number is (571) 272-7656. The examiner can normally be reached on M-F from 7:30 to 4:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xiao Wu

can be reached at (571) 272-7661. The fax phone Number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jeffery A. Brier/  
Primary Examiner, Division 2628